

REMARKS

Claims 1 through 3, 5 through 20 and 22 through 34 are currently pending in the application.

Claims 4 and 21 have been canceled.

Claims 9 through 17 and 26 through 34 are withdrawn from consideration as being drawn to a non-elected invention.

Claims 1 through 3, 5 through 8, 18 through 20 and 22 through 25 stand rejected.

Claims 7 and 24 are canceled.

Claims 1 through 3, 5, 6, 8, 18 through 20 and 22, 23 and 25 have been amended.

This amendment is in response to the final Office Action of November 17, 2003.

ENTRY OF AMENDMENTS

Applicants respectfully request entry of the amendments presented herein as they add no new matter, raise no new issues, and are timely filed.

35 U.S.C. § 112 Claim Rejections

Claims 1 through 3, 5 through 8, 18 through 20 and 22 through 25 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Applicants have amended the claimed invention as suggested by the Examiner for the presently claimed invention to particularly point out and distinctly claim the subject matter of the invention to comply with the provisions of 35 U.S.C. § 112. The preamble of claims 1 through 3, 5 through 8, 18 through 20 and 22 through 25 has been amended to make it clear that the claim is directed to an “assembly,” and that the “apparatus” and the “substrate” are parts of the assembly. Furthermore, in the amended claims, it is now apparent that the apparatus, rather than the apparatus-substrate assembly, carries out the claimed function of “placing a plurality of conductive spheres on a substrate.” Moreover, in the amended claims, it is now apparent that the word “substrate” in the preamble to claims 1 and 18 correspond to the “substrate” enumerated later in the claims. Therefore, presently amended claims 1 through 3, 5, 6, 8, 18 through 20, 22,

23 and 25 are allowable under the provisions of 35 U.S.C. § 112.

35 U.S.C. § 103(a) Rejections

Obviousness Rejection Based on Sakemi et al. (U.S. Patent 5,655,704) in view of Yeh et al. (U.S. Patent 5,607,099)

Claims 1 through 3, 6 through 8, 18 through 20 and 23 through 25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sakemi et al. (U.S. Patent 5,655,704) in view of Yeh et al. (U.S. Patent 5,607,099). Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicants submit that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicants' disclosure.

Applicants respectfully submit that the combination of the cited prior art fails to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 because art as combined in the rejection fails to teach or suggest all of the claim limitations. In particular, the combination of the cited prior art does not teach or suggest the claim element calling for "a substrate bearing conductive sites comprising one of recessed sites and level sites with respect to said upper surface".

The rejection expressly uses Yeh to teach the above element. See second and third sentences of item five on page three of the Office Action. However, the substrate of Yeh does not contain any conductive sites. The preferred material for Yeh's substrate is silicon, a material which is not a conductor. Col. 3, lines 59-63. Furthermore, because Yeh's method of forming recesses involves the etching of hollows in a substrate (Col. 24, lines 8 through 50), even if a material which happened to be conductive were to be used as a "substrate," the resulting

substrate of Yeh's etch process cannot be said to simply contain "conductive sites" because the entire device would be conductive.

Claims 7 and 24 are canceled because they pertain to upwardly-projecting bond pads.

Applicants thus respectfully submit that claims 1 and 18 are allowable, and claims 2, 3, 5, 6, 8, 18 through 20, 22, 23 and 25 are allowable as depending from allowable independent claims.

Applicants request the allowance of claims 1 through 3, 5, 6, 8, 18 through 20, 22, 23 and 25 and the case passed for issue.

Respectfully submitted,



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